

REMARKS

The Final Office Action of November 30, 2007 was received and carefully reviewed. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

By this amendment, claim 1 is amended to further define Applicants' claimed invention, and claim 5 is canceled without prejudice or disclaimer. Consequently, claims 1-4 and 6-10 remain pending in the instant application, of which claim 1 is independent.

Claims 1-8 stand rejected under 35 U.S.C. §102(a or e) as being anticipated by Panaccione (U.S. 2003/0005599), claims 9 and 10 are rejected under 35 U.S.C. §102(a or e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Panaccione, and claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Panaccione in view of Hauser (US 6,247,250). Applicants respectfully traverse these rejections for at least the reasons advanced in detail below.

Independent claim 1, as amended, recites an orthotic insert having a first and a second portion being formed from heat mouldable ethyl vinyl acetate, wherein "*the second portion has a substantially J-shaped configuration which extends partially around the periphery of the insert corresponding to the heel and arch regions of the person's foot,*" (emphasis added). In direct contrast to Applicants' claimed invention, Panaccione is merely directed towards a heel piece having a U-shaped configuration. As shown in FIGs. 1 and 5A, for example, Panaccione teaches heel pieces 20 explicitly requiring U-shaped configurations. Moreover, Panaccione teaches, in FIG. 4, a heel piece 20 and a heel cup 30, none of which have "a substantially J-shaped configuration which extends partially around the periphery of the insert corresponding to the heel and arch regions of the person's foot," as required by amended independent claim 1, and hence dependent claims 2-4 and 6-10. Thus, Applicants respectfully assert that Panaccione fails to teach or suggest the combination of features recited by at least independent claim 1, whereby the Final Office Action fails to establish a *prima facie* case of obviousness.

In further contrast to Applicants' claimed invention, Hauser merely teaches a multiple layered insert without anything related to an insert having "a substantially J-shaped configuration which extends partially around the periphery of the insert corresponding to the heel and arch regions of the person's foot," as required by amended independent claim 1.

Accordingly, Applicants respectfully assert that Hauser fails to remedy the deficiencies of Panaccione, as detailed above. Thus, Applicants respectfully assert that the Final Office Action further fails to establish a *prima facie* case of obviousness.

With regard to claims 9 and 10, Applicants reassert that Panaccione is completely silent with respect to any relationship between deformation resistances, as implied by the Final Office Action. Accordingly, the Final Office Action attempts to remedy this deficiency of Panaccione by alleging that the relative “resistance to deformation,” as recited by claims 9 and 10, are somehow “considered either inherent or at least obvious.” Applicants again assert that Panaccione neither teaches nor suggests any relative resistance to deformation, as recited by claims 9 and 10.

According to Panaccione, at paragraph [0032], “forefoot piece 10 may be manufactured from laminated layers 12A-12C and 12A’-12C’ of material selected to provide various sizing, cushioning, aeration, and durability properties.” However, Panaccione provides no teaching or suggestion, either implicitly or explicitly, of any relative resistance to deformation of the forefoot piece 10 and the heel piece 20. Moreover, in general, Panaccione is completely silent with regard to relative mechanical properties between the forefoot piece 10 and the heel piece 20. Thus, Applicants assert that Panaccione may not be properly considered to provide any motivation that “[t]he exact % difference in resistance is considered either inherent or at least obvious,” as alleged by the Final Office Action.

Furthermore, Applicants again assert that one of ordinary skill in the art would not have been properly motivated to modify Panaccione to provide for any relative “resistance to deformation,” as recited by claims 9 and 10. Specifically, the relative resistance to deformation may not be properly considered a result-effective variable, but a ratio of deformation resistances of a second portion, which includes a heel region, of an orthotic insert to a first portion (not including the heel region) of the orthotic insert. Here, claims 9 and 10 recite ranges of the second section having --30 to 70 %-- and --40 to 60%-- “more resistant to deformation than said first portion,” respectively. Thus, none of the prior art of record, especially Panaccione, recognizes that different portions/regions of an orthotic insert may function to have different relative resistances to deformation, as recited by claims 9 and 10.

As directed by MPEP 2144.05(II)(B), “[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).” Accordingly, since the prior art of record, or any logical scientific reasoning provided by the Final Office Action, does not recognize that different portions/regions of an orthotic insert may function to have different relative resistances to deformation, as recited by claims 9 and 10, then the parameter recognized, i.e., relative resistance of deformation, was not recognized in the art to be a result-effective variable. Thus, the conclusion that it would have been obvious “to make the materials with the % difference as claimed,” is invalid since the parameter of relative resistance to deformation is not recognized as a result-effective variable. Therefore, Applicants assert that the Final Office Action fails to establish a *prima facie* case of obviousness with regard to at least claims 9 and 10.

In view of the foregoing, it is respectfully requested that the rejections of record be reconsidered and withdrawn by the Examiner, claims 1-4 and 6-10 be allowed, and the application be passed to issue. If a conference would expedite prosecution of the instant application, the Examiner is hereby invited to telephone the undersigned to arrange such a conference.

Respectfully submitted,

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